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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,109	03/16/2001	Kaoru Shimamura	1046.1248	8921

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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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06/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/809,109	<b>Applicant(s)</b> SHIMAMURA, KAORU	
	<b>Examiner</b> Yogesh C. Garg	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,5-9,11,12,16,18-20,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-9,11-12,16,18-20 & 23-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/2/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment received on 5/1/2007 is acknowledged and entered. The applicant has amended claims 1, 7, 8, 11-12, 16, 20, 23-24, and canceled claims 2, 13 and 17. Currently claims 1, 5-9, 11-12, 16, 18-20, and 23-24 are pending for examination.

### ***Response to Arguments***

2. Applicant's arguments (see pages 9-12 of Remarks) filed on 5/1/2007 have been considered. In view of the current amendments made to claims 1, 7, 11, 20, 23 and 24 rejection of claims 1, 5-9, 11, 20, and 23-24 under 35 U.S.C. 101 is withdrawn.

Also, in view of the current amendments made to claims 1, 11 and 12, rejection of claims 1, 5-6, 11 and 12 under 35 U.S.C. 112, second paragraph is withdrawn.

Applicant's arguments filed on 5/1/2007 (see Remarks, page 9) against art rejection of claims under 35 USC 103 (a) as being unpatentable over Walker in view of Ying and further in view of Szabo have been fully considered but they are not persuasive. The applicant argues that Ying does not disclose "goods being element of font sets, as recited by the independent claims". The examiner respectfully disagrees because the applicant has made a conclusive statement without providing evidence or reasons contrary to the examiner's support for the rejection of claims. In fact, Ying does teach selling a variety of font sets or individual fonts (see at least Abstract, col.2, lines

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18-45, " *It is still another object of the present invention to provide a system which aids in **the buying and selling of fonts**. .....a computerized method of enabling a user to select a font is provided. The method comprises **storing information about each of a set of fonts**, including a value of each of a plurality of attributes for each such fonts. ....* ", and col.10, lines 14-21, " *FIG. 1 provides and overview of one of many possible embodiments for practicing the various aspects of the present invention. It discloses a system 100 for enabling customers to select and purchase fonts over a computer network, in this, case the Internet 102. The system includes an e-commerce server 104 which sells fonts, and one or more client computers 106 from which a user can access the server 104 for the purpose selecting and purchasing a font.* ".

Since the applicant's arguments against Ying are not persuasive, as analyzed above, the rejection of claims 1, 5-9, 11-12, 16,18-20, and 23-24 as being unpatentable over Walker/Ying/Szabo is sustainable.

This is a Final office action.

3 Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 103***

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1,5-6,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Publication 2006/0212358 A1), hereinafter referred to Walker in view of Ying, and further in view of Szabo.

**Regarding claim 1**, Walker discloses a system for selling goods through a computer network (Figs 1-3 and Figs 5 through 12), where the goods are a variety of elements which are different from each other and are sold one by one and the system comprising:

a unit storage section (Price database "86", in fig.3 ) configured to store a plurality of units for each good, each unit being a price per element corresponding to a range of elements to which the goods being purchased is to be applied, an element being an unit of the goods being purchased (see Figs 5A, 5B, 6C and 13. Different price units are displayed for each good depending upon different range of elements, that is fourth price unit of \$2.75 corresponds to the fourth condition, that is number of elements being purchased are equal to or more than 10, the third price unit of \$ 2.90

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is applicable to number of elements being purchased are 6 or between 6 and 10 and so on );

a detecting section configured to detect the number of elements to be purchased on the basis of information of one or more goods to be purchased which is received from a purchaser(see at least Fig.13 which indicates that the system detects the quantity of goods for the transaction);

a purchase record storage section configured to store the number of elements purchased by a purchaser in the past and an addition section configured to read the number of elements purchased in the past from the purchase record storage section when the number of elements is detected by the detecting section and adding the read number to the detected number, a reading section configured to read at least one unit corresponding to the elements to be purchased on the basis of the number of elements detected and a result of addition by the addition section, a first calculating section configured to calculate the number of elements belonging to a range to which the read at least one unit is to be applied and a second calculating section configured to calculate the purchase price by using the read at least one unit price and the number of elements calculated (see at least paragraphs 0150-0153, 0168 and figs.3, 6C, 15, 16A and 20. Transaction database 90 and customer database 92 store records of the past transactions, such as shown in Fig.15 customer database 92, as shown in fig.16 A indicates a range of elements, that is Gold, Bronze, Silver, Retail corresponding to the total number of elements purchased for an item. Note: The range of elements represented by Gold, Bronze, Silver and Retail correspond to different

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range of elements as shown in Fig.6C. Fig.20 and paragraph 153 discloses adding records of past purchases and current transaction for determining and providing progressive discounts for current purchases. Referring to Fig. 6C, 16 A and 20 it is apparent, for example, if an user wants to buy 6 items currently and has already purchased 5 items in the past [based on past records user is eligible for Bronze tier that is the unit price corresponding to second price of \$2.95 ] but on adding the current quantity of 6 items he would be eligible for both Silver and Gold ranges, that is for 5 items, Silver tier is applicable and for 6<sup>th</sup> item Gold tier would be applicable. Based upon the unit prices of corresponding tiers the purchase prices for the current first 5 items and 6<sup>th</sup> item would be calculated).

Walker does not disclose a system wherein the "goods" denotes a variety of font sets, wherein the font set comprises of elements, element being a character. However, Ying, in the same field of endeavor, that is selling goods on line teaches selling goods denoting a variety of font sets, wherein the font set comprises of elements, element being a character (see at least col.2, lines 18-45, "*It is still another object of the present invention to provide a system which aids in **the buying and selling of fonts**. .....a computerized method of enabling a user to select a font is provided. The method comprises **storing information about each of a set of fonts**, including a value of each of a plurality of attributes for each such fonts.*

..... ", and col.10, lines 14-61, "*FIG. 1 provides and overview of one of many possible embodiments for practicing the various aspects of the present invention. It discloses a system 100 for enabling customers to select and purchase fonts over a computer network, in this, case the Internet 102. The system includes an e-commerce server 104 which sells fonts, and one or more client computers 106 from which a user can access the server 104 for the purpose selecting and*

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***purchasing a font.....*** "). In view of Ying, it would have been obvious to one of an ordinary skilled in the art to modify the system of Walker to incorporate the features of Ying of selling goods denoting a variety of font sets, wherein the font set comprises of elements, element being a character because it will enable the users to sell and purchase fonts online and allow the users to vary the size of his letters to pack text more densely, using a variety of fonts to visually distinguish different parts of the text, for aesthetic use, art decoration, etc., as explicitly suggested in Ying (see at least col.1, line 59-col.2, line 11 and col.2, line 59-col.3, line 5).

Walker does not disclose a data storage section configured to store a set of the data and a creating section configured to create a supply file including data corresponding to information of the elements to be purchased by using the set of data stored in the data storage section and including data purchased by the purchaser in the past and a supplying section configured to supply the created supply file to the purchaser. However, in the same field of online selling and buying, Szabo discloses a data storage section, creating section creating a supply file including data corresponding to information of the elements to be purchased by using the set of data stored in the data storage section and including data purchased by the purchaser in the past and a supplying section supplying the created supply file to the purchaser (see at least col.6, lines 11-41 where in the purchaser's previous shopping lists are stored and made available to him for his current shopping resulting in a new shopping list including data from the previously purchased items and any changes due to his current requirements are sent from the server to the client.). In view of Szabo, it would



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be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Walker to include the features of a data storage section, creating section creating a supply file including data corresponding to information of the elements to be purchased by using the set of data stored in the data storage section and including data purchased by the purchaser in the past and a supplying section supplying the created supply file to the purchaser because, as explicitly argued in Szabo, it would provide great tool and convenience to the purchasers purchasing repetitive items in constructing shopping lists using the previously purchased shopping lists as in many instances the previously stored shopping list may be nearly complete and eliminating the need for the purchaser to start from scratch.

**Regarding claim 5**, the limitation that the set of data is a font set data and that a piece of the data is font data as an element of the font set data is already covered in claim 1 analyzed above.

**Regarding claim 6**, Walker/Ying/Szabo combined discloses further comprising a data storage section storing data set and the set of data represents sentences divided every predetermined range, wherein the data represents the range constructing sentences (see at least Ying col.2, line 21-col.3, line 6 and col.30, line 30-col.31, line 4). In view of Ying, it would have been obvious to one of an ordinary skilled in the art to modify the system of Walker to incorporate the features of Ying of selling goods denoting a variety of font sets, wherein the font set

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comprises of elements, element being a character, section storing data sets and that the set of data represents sentences divided every predetermined range, wherein the data represents the range constructing sentences because it will enable the users to sell and purchase fonts online and allow the users to vary the size of his letters to pack text more densely, using a variety of fonts to visually distinguish different parts of the text, for aesthetic use, art decoration, etc., as explicitly suggested in Ying (see at least col.1, line 59-col.2, line 11 and col.2, line 59-col.3, line 5).

Regarding claims 11-12, their limitations are closely parallel to the limitations of claim 1 and therefore they are analyzed and rejected on the basis of same rationale.

4.2. Claims 7-9, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Publication 2006/0212358 A1), hereinafter referred to Walker in view of Ying.

Regarding claims 7-9, Walker combined with Ying discloses a system (see Walker at least Figs 1-2) for a purchaser to purchase goods through a network, the system comprising a transmitting section configured to transmit information of one or more goods to be purchased to a seller and the goods are different from each other, a receiving section configured to receive a price of the one or more goods to be purchased and a display controlling section configured to display the received price on a display (see Walker at least Figs 1-2 and paragraphs 0068-0071).

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Walker does not disclose that the goods being purchased denote a variety of elements of font sets which are different from each other and are sold one by one, wherein the font set comprises of elements, element being a character. However, Ying, in the same field of endeavor, that is selling goods on line teaches selling goods a variety of elements of font sets which are different from each other and are sold one by one, wherein the font set comprises of elements, element being a character (see at least col.2, line 13-col.3, line 40, col.10, line 14-col.16, line 61). In view of Ying, it would have been obvious to one of an ordinary skilled in the art to use the system of Walker incorporating the features of Ying of selling goods denoting a variety of font sets, wherein the font set comprises of elements, element being a character because it will enable the users to sell and purchase fonts online and allow the users to vary the size of his letters to pack text more densely, using a variety of fonts to visually distinguish different parts of the text, for aesthetic use, art decoration, etc., as explicitly suggested in Ying (see at least col.1, line 59-col.2, line 11 and col.2, line 59-col.3, line 5).

Note: Claims 7-9 are recited as system claims comprising a transmitting section, a receiving section and a display controlling section which correspond to the client's terminal in the applicant's disclosure (see Figs 1-2 and pages 6-8). Claims Directed to an Apparatus/system must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a " recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

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a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claims 7-9 and 23, including a transmitting section, a receiving section and a display controlling section on a client's terminal are disclosed in Walker as described herein. The other intended use limitations, that is, how the price is calculated/determined and what received information data should consists of do not distinguish the claimed apparatus from the prior art. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant claims 7-9 and 23 they do not recite structure configured to calculate/determine price or create supply files hence the prior art of Walker which discloses all the structural components, that is a transmitting section, a receiving section and a display controlling section it is capable of performing the intended use, and therefore it meets the limitations recited in claims 7-9 .

Regarding claim 23, its limitations are closely parallel to the limitations already covered in claims 7-9 and is therefore analyzed and rejected on the basis of the same rationale used for claims 7-9.

4.3. Claims 16, 18-20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker/Ying/ Szabo.

Regarding claims 16, 18-20 and 24, their limitations are already covered while analyzing the limitations of claims 1, 5-9 and, therefore, are analyzed and rejected as being unpatentable over Walker/Ying/ Szabo using the same rationale.

### ***Conclusion***

**5. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

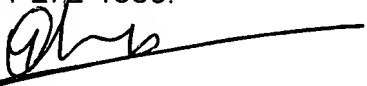
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**6.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Yogesh C Garg  
Primary Examiner  
Art Unit 3625YCG  
5/30/2007